REMARKS

This responds to the Office Action mailed on March 13, 2008.

Claims 1, 9 and 18 are amended, no claims are canceled or added; as a result, claims 1-25 remain pending in this application.

§103 Rejection of the Claims

Claims 1-25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Coss et al. (U.S. 6,154,775) in view of Venkatachary et al. (U.S. 6,212,184) and further in view of Randy H. Katz's, Contemporary Logic Design (hereinafter "Katz"). The determination of obviousness under 35 U.S.C. § 103 is a legal conclusion based on factual evidence. *See Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.,* 411 F.3d 1332, 1336-37 (Fed.Cir. 2005). The legal conclusion that a claim is obvious within § 103(a) depends on at least four underlying factual issues set forth in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17, 86 S.Ct. 684, 15 L.Ed.2d 545 (1966). The underlying factual issues set forth in *Graham* are as follows: (1) the scope and content of the prior art; (2) differences between the prior art and the claims at issue; (3) the level of ordinary skill in the pertinent art; and (4) evaluation of any relevant secondary considerations.

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir.1988). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested, by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) ; M.P.E.P. § 2143.03. "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970) ; M.P.E.P. § 2143.03. As part of establishing a *prima facie* case of obviousness, the Examiner's analysis must show that some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead an individual to combine the relevant teaching of the references. *Id.* To facilitate review, this analysis should be made explicit. *KSR Int'l v. Teleflex Inc., et al.*, 127 S.Ct. 1727; 167 L.Ed 2d 705; 82 USPQ2d 1385 (2007) (citing *In re Kahn*, 441 F. 3d 977, 988 (Fed. Cir. 2006)). Applicant respectfully submits

that the claims contain elements not found in the combination of Coss, Venkatachary and Katz, therefore the claims are not obvious in view of the combination.

For example, claim 1 recites "parsing the at least one protocol state machine definition to form a set of parsed protocol state rules in a binary format, said parsed protocol state rules including at least one condition and at least one action associated with the condition", where the protocol state machine definition is in a text format. Claims 9 and 18 recite similar language. Applicant has reviewed Coss, Venkatachary and Katz and can find no teaching or suggestion of parsing a protocol state machine definition in a text format to a set of rules in a binary format. Coss appears to download a text formatted table as illustrated in Figure 3. Coss does not disclose transforming the table into a binary format. Neither Venkatachary nor Katz disclose any parsing of rules in a text format to a binary format. In view of the above, none of Coss, Venkatachary or Katz, alone or in combination, discloses parsing a protocol state machine definition in a text format to form a set of parsed protocol state rules in a binary format as recited in claims 1, 9 and 18. As a result, there are differences between claims 1, 9 and 18 and the cited references. Therefore the claims are not obvious in view of the combination of Coss, Venkatachary and Katz. Applicant respectfully requests reconsideration and the withdrawal of the rejection of claims 1, 9 and 18.

Claims 2-8 depend from claim 1, claims 10-17 depend from claim 9 and claims 19-25 depend from claim 18. These dependent claims are therefore patentable over Coss and Katz for the reasons argued above, and are also patentable in view of the additional elements which they provide to the patentable combination. If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is also nonobvious. MPEP § 2143.03.

Further, claims 6, 14 and 23 recite that "the at least one action comprises saving the result of the at least one action for use in a later executed rule in the set of parsed protocol state rules" (emphasis added). The Office action states that Coss, at column 5, lines 40-52 teaches the recited language. Applicant respectfully disagrees with this interpretation of Coss. The cited section of Coss states that the system may "cache the results of rule processing." Applicant notes that Coss does not teach saving the results of an individual rule for later use by other individual rules, rather Coss appears to teach caching the results a set of rules applied to a packet. Further, the caching is not used as input to later executed rules; rather the caching of a result is used to

bypass rules processing for later similar packets. Bypassing a rule implies that the result is not used in the rule, rather the rule is bypassed and therefore not used. Further, Applicant has reviewed Venkatachary and Katz and can find no teaching or suggestion of saving the result of the at least one action for use in a later executed rule. Thus the combination of Coss, Venkatachary and Katz fails to teach or suggest each and every element of claims 6, 14 or 23. Therefore claims 6, 14 and 23 are not obvious in view of the combination. Applicant respectfully requests reconsideration and the withdrawal of the rejection of claims 6, 14 and 23.

Reservation of Rights

In the interest of clarity and brevity, Applicant may not have addressed every assertion made in the Office Action. Applicant's silence regarding any such assertion does not constitute any admission or acquiescence. Applicant reserves all rights not exercised in connection with this response, such as the right to challenge or rebut any tacit or explicit characterization of any reference or of any of the present claims, all inherency assertions, the right to challenge or rebut any asserted factual or legal basis of any of the rejections, the right to swear behind a cited reference such as provided under 37 C.F.R. § 1.131 or otherwise, or the right to assert co-ownership of a cited reference. Applicant does not admit that any of the cited references or any other references of record are relevant to the present claims, or that they constitute prior art.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 373-6954 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

SCHWEGMAN, LUNDBERG & WOESSNER, P.A.
P.O. Box 2938
Minneapolis, MN 55402
(612) 373-6954

Date August 13, 2008 By _____
Rodney L. Lacy
Reg. No. 41,136

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 13th day of August 2008.

Amy Moriarty _____
Name Signature